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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/394,097	09/13/1999	PAUL JOSEPH DAVIS	DAVIS 11-16-8	3702

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WILLIAM H BOLLMAN  
MANELLI DENISON & SELTER PLLC  
2000 M STREET NW  
SUITE 700  
WASHINGTON, DC 20036-3307

EXAMINER

SING, SIMON P

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/394,097

**Applicant(s)**

DAVIS ET AL.

**Examiner**

Simon Sing

**Art Unit**

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 10-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 10 and 15 recite simultaneously recording in the preamble.

However, in the body of the claim, no recording step (means for claim 15) is further recited.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li US 5,646,990 in view of Sacca US 5,692,042 and further in view of Chamberlin et al. US 4,817,127.

2.1 Regarding claim 1, Li discloses a full-duplex speakerphone in figures 1 and 2 (column 4, lines 62-67; column 5, lines 1-20; column 6, lines 11-28), comprising:

- a microphone signal from microphone 210 (column 6, lines 29-33);
- gain modules 212 and 240 (figure 2); and
- a summer 220 (figure 2).

Li fails to teach injecting a message playback signal into the speakerphone, and a recording module for recording a telephone conversation from telephone line 274.

However, Sacca discloses a voice messaging system with speakerphone capability in figure 1 (column 7, lines 23-51). Sacca teaches injecting a tape playback message via switch 118 into a receiving path at the input of speaker amplifier 120, and then to a transmitting path at the input of line amplifier 142 for transmitting to a far end party in a speakerphone mode (column 8, lines 7-14, 26-53).

In addition, Chamberlin discloses a modular telephone system in figures 4 and 6. Chamberlin teaches combining a speakerphone 18 (column 13, lines 29-31) with two recording/playback modules 12 and 14, one for recording a telephone conversation and one for playing an outgoing announcement (column 22, lines 38-43). Chamberlin further teaches independent operations of the speakerphone 18 and each recording/playback module (column 16, lines 19-43), and the recording/playback module can be a telephone answering device (column 21, lines 27-36).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Li's reference with the teaching of Sacca and Chamberlin, so that the speakerphone of Li would have been connected to a recording

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device for recording a telephone conversation, and a tape playback module, such as a telephone answering device for pre-recording a message, and summing said pre-recorded message at a summer at the input of speaker amplifier 234 and at another summer at the input of line amplifier 270 of a transmitting path, so that a far end party would have been able to converse with a near end party and to hear a playback message at the same time, such a modification would have enabled a near end user to play a pre-record a message to a far end party during a telephone conversation, and also would have enabled the near end party to record said telephone conversation.

2.2 Regarding claim 2, it is inherent that a recording/playback module, such as the recording/playback module of Chamberlin, has an amplifier in its signal output path.

2.3 Regarding claim 3, Li teaches a fixed gain amplifier 212 and an automatic gain control (AGC) 240, and it is a matter of design choice to have two amplifiers, a fixed gain and a variable gain in a signal path.

2.4 Regarding claim 4, Li teaches a fixed gain amplifier 212 and an automatic gain control (AGC) 240 (figure 2).

2.5 Regarding claim 5, Li teaches switched gain loss modules 250 and 251 (column 7, lines 6-11).

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2.6 Regarding claim 6, as discussed in claim 1, the modified Li reference teaches that the playback message is injected at a summer at the input of line amplifier 270.

2.7 Regarding claim 7, Li teaches a digital to analog converter (D/A) 256 in figure 2.

2.8 Regarding claim 8, Li teaches a Tx speech detector 224 (figure 2; column 7, lines 1-6).

2.9 Regarding claim 9, as discussed in claim 1, the recording module is a telephone answering device (Chamberlin, column 21, lines 27-36).

2.10 Regarding claims 10 and 15, Li discloses a full-duplex speakerphone in figures 1 and 2 (column 4, lines 62-67; column 5, lines 1-20; column 6, lines 11-28), comprising:

establishing a connection with a far end party for a telephone conversation in a full-duplex speakerphone mode (column 4, lines 62-66); and

generating a microphone signal (column 4, lines 67 to column 5, line 9); and

Li fails to teach injecting a message playback signal into the speakerphone, and a recording module for recording a telephone conversation from telephone line 274.

However, Sacca discloses a voice messaging system with speakerphone capability in figure 1 (column 7, lines 23-51). Sacca teaches injecting a tape playback message via switch 118 into a receiving path at the input of speaker amplifier 120, and then to a transmitting path at the input of line amplifier 142 for transmitting to a far end party in a speakerphone mode (column 8, lines 7-14, 26-53).

In addition, Chamberlin discloses a modular telephone system in figures 4 and 6. Chamberlin teaches combining a speakerphone 18 (column 13, lines 29-31) with two recording/playback modules 12 and 14, one for recording a telephone conversation and one for playing an outgoing announcement (column 22, lines 38-43). Chamberlin further teaches independent operations of the speakerphone 18 and each recording/playback module (column 16, lines 19-43).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Li's reference with the teaching of Sacca and Chamberlin, so that the speakerphone of Li would have been connected to a recording device for recording a telephone conversation, and a tape playback module for pre-recording a message, and summing said pre-recorded message at a summer at the input of speaker amplifier 234 and at another summer at the input of line amplifier 270 of a transmitting path, so that a far end party would have been able to converse with a near end party and to hear a playback message at the same time, such a modification would have enabled a near end user to play a pre-record a message to a far end party during a telephone conversation, and also would have enabled the near end party to record said telephone conversation.

2.11 Regarding claim 11 and 16, Li teaches an AGC 240 for adjusting the signal level of microphone 210.

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2.12 Regarding claim 12 and 17, it is inherent that a tape player has a gain control circuitry, such as volume control for controlling its output signal level.

2.13 Regarding claims 13 and 18, the modified Li reference, teaches injecting the play message at the input of line amplifier 270, such that the AGC 240 is unable to adjust the signal level of both microphone 210 and the playback message. However, it is obvious to a circuit designer such that the playback message can be injected at a point before (for analog signal) or after the A/D 216 (for digital signal) as a design choice.

2.14 Regarding claim 14 and 19, as discussed before, the playback message is injected at a summer at the input of line amplifier 270 which is after the AGC 240.

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 1-19 have been considered but are moot in view of the new ground(s) of rejection.

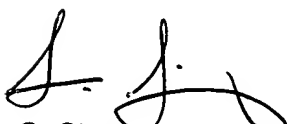
### ***Conclusion***

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Simon Sing whose telephone number is (703) 305-3221. The examiner can normally be reached on Monday - Friday from 8:30 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached at (703) 305-4895. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.



S. Sing

03/09/2004



FAN TSANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600